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10/538,890	03/01/2006	Martin Kunz	11-2-22990/INP 3/PCT	5145
324 7590 03/31/2009 JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591				
EXAMINER HORNING, JOEL G				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/538,890

**Applicant(s)**

KUNZ ET AL.

**Examiner**

JOEL G. HORNING

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.  
4a) Of the above claim(s) 6 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5 and 7-23 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/CIS)  
Paper No(s)/Mail Date 09-02-05  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group A, claim(s) 1-22, drawn to a process for forming a coating on a substrate.

Group B, claim(s) 23, drawn to a substrate with a reactive coating produced by the process of claim 1.

The inventions listed as Groups A-B do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature between the different groups is a substrate having a functional layer disposed on it, however, WO-00/24527 (as literally translated in US 6548121) teaches the production of a substrate with a layer having good adhesion functionality (option "c1", col 1, line 40 through col 2 line 9). Since the common technical feature was known, it is not a special technical feature.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Different photoinitiator compounds and mixtures of compounds as found on pages 8-10 as well as in examples 1-4 of the specification.

Different substrates as found on pages 3-6 of the specification.

During a telephone conversation with Ms Loggins on March 25<sup>th</sup>, 2009 a provisional election was made with traverse to prosecute the invention of group A, the photoinitiator species found in example 2 of the specification and polypropylene as the substrate: which reads upon **claims 1-5 and 7-22**. Affirmation of this election must be made by applicant in replying to this Office action. Claim 6 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the

requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

#### ***Claim Objections***

1. **Claims 2 and 19-20** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In the case of claim 2, the optional "three-dimensional workpiece" encompasses all possible inorganic or organic substrates of claim 1, so it does not further limit the claim. In the case of claim 19, the choice of "bringing into contact" encompasses all possible means of depositing a coating, so it does not further limit claim 1. In the case of claim 20, if the coating material can be organic or not organic (inorganic) the coating material can be any material at all and so the claim does not further limit claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. **Claims 1-17 and 19-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al (WO-00/24527, as literally translated in US 6548121).

The instant **claim 1** is directed towards a process for the production of a coating on an inorganic or organic substrate, wherein:

- I. A low temperature plasma treatment, a corona discharge treatment, high energy treatment or a flame treatment is carried out on the substrate;
- II. A melt, solution, suspension or emulsion of at least one activatable initiator, which may optionally include at least one ethylenically unsaturated compound, with at least one of the initiators or the unsaturated compounds containing a

group that interacts with a subsequently applied coating or reacts with groups contained therein, with the effect of promoting adhesion, and

III. The coated substrate is heated and/or irradiated with electromagnetic waves, and an adhesion promoter layer is formed

IV. The substrate treated this way is provided with a further coating which contains reactive groups that react with those of the adhesion promoter layer and or interact with the adhesion promoter layer.

Bauer et al teaches a process for producing a coating on an organic or inorganic substrate in order to promote adhesion. This method comprises: a corona discharge is carried out on the substrate (step "a"), one or more activatable initiators containing at least one ethylenically unsaturated group (**claim 7**) are applied to the substrate (step "b"), the substrate is coated with composition comprising at least one ethylenically unsaturated monomer or oligomer (**claim 8**) and is irradiated with electromagnetic waves so that the coatings are cured (col 1, line 50 through col 2, line 8).

Bauer et al teaches that the initiator can be in the form of a solution and be applied by spraying (**claim 11**) (col 15, lines 15-17).

Even though Bauer et al teaches performing the irradiation step after depositing the further coating layer (instead of applicant's claimed irradiation before the further deposition), MPEP 2144.04 (IV) states: "selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results."

It is also readily apparent from the fact that the layers adhere well together that the layers interact with each other (if they had no interaction, they would not adhere at all). Therefore, there must be some sort of functional groups on the adhesion promotion layer and the further coating layer that allow them to interact.

Regarding **claim 2**, Bauer et al teaches that the substrate can be a three-dimensional workpiece (col 3, lines 12-15).

3. Regarding **claims 3-5**, Bauer et al teaches polyolefins (e.g. polypropylene) as desired substrates for the process (col 3, lines 12-22).
4. Regarding **claim 6**, Bauer et al teaches using benzophenones for the photoinitiator (col 17, lines 49-65).
5. Regarding **claim 9**, Bauer et al teaches that the ethylenically unsaturated compound can be a methacrylate (col 15, lines 28-33).
6. Regarding **claim 10**, Bauer et al teaches using air as the plasma gas (col 2, lines 20-25).
7. Regarding **claims 12 and 13**, which claim different concentrations of the components of the mixtures. MPEP 2144.05 (II) states: "Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. '[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.'"

8. Regarding **claim 14**, Bauer et al teaches adding "additives customary in the art" to the composition (col 21, lines 57-60).
9. Regarding **claim 15**, Bauer et al teaches applying the coating to a thickness of between 1 to approximately 100 microns (col 19, lines 52-57), which is encompassed by applicant's claimed range.
10. Regarding **claim 16**, Bauer et al teaches performing the irradiation step with UV/VIS radiation col 2, lines 5-9), and further teaches that UV/VIS radiation is to be considered between 250 nm and 450 nm (col 17, lines 52-55), which is encompassed by applicant's claimed range.
11. Regarding **claim 17**, Bauer et al teaches irradiating the coated substrate through a mask, so only certain areas are exposed to the irradiation (col 3, lines 1-7).
12. Regarding **claim 19**, whatever method that is used to further coat the substrate, it will inherently include bringing the further coating into contact with the substrate, otherwise the substrate is not being coated.
13. Regarding **claim 20**, whatever materials are used to further coat the substrate will inherently be either organic or inorganic.
14. Regarding **claims 21-22**, Bauer et al teaches that the coating can be a printing ink (col 19, lines 52-57), from which it is readily apparent that the coating is either a solid or a liquid.
15. **Claim 18** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al (US 6548121) as applied to claim 1 above, and further in view of Kohler et al (US 6251963).

Bauer et al teaches that the method is used for forming photoinitiator layers for image forming resist coatings (col 23, lines 10-16), but does not say how such images are formed by resist technology.

However, '963 further teaches that images are formed by resist technology by covering parts of the wet or dry resist layer with a photomask and then irradiating the layer with electromagnetic waves to crosslink a pattern in the resist (the UV/VIS exposure step) and removing the unexposed (not crosslinked) regions of the photoresist by using a solvent (col 21, lines 13-23).

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to modify Bauer et al to cover the deposited structure of a photoinitiator layer and a monomer or oligomer containing layer with a photomask so that the irradiation step would only crosslink a pattern in the coating and then to remove the non-crosslinked regions of the coating (photoinitiator and monomer/oligomer) by using a solvent, in order to form an image in the coating as desired by Bauer et al. Using this method is obvious, because it was a known method for producing an image in a photoinitiator layer and would produce predictable results.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**16. Claims 1, 2, 10-13, 15-21** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U. S. Patent No. 7455891. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '891 claims are sufficient to anticipate species from the markush groups in the claims. Additionally, the photoinitiator compounds are in solutions (claim 6) and the claims require that the coatings are strongly adherent, which means that the layers must interact with each other. Furthermore: MPEP 2144.05 (II) states that "Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. '[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.'"

**17. Claims 3-5, 14 and 22** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U. S. Patent No.

7455891 as applied in the double patenting rejection above further in view of WO-00/24527, as literally translated in US 6548121. Though '891 does not claim the the substrate of claims 3-5, the additives of claim 14, or the coatings of claim 22, as described in the Bauer et al rejections of those claims, it would have been obvious to a person of ordinary skill in the art at the time of invention to perform those claimed limitations since they were known to the art to be suitable and would produce predictable results.

18. **Claims 1, 2, 10, 12, 13 and 15-21** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10556609. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '609 claims are sufficient to anticipate species from the markush groups in the claims. Additionally, the photoinitiator compounds are in solutions (claim 7) and the claims require that the coatings are strongly adherent, which means that the layers must interact with each other. Furthermore: MPEP 2144.05 (II) states that "Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. '[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.'"

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**19. Claims 3-5, 7-9, 11, 14 and 22** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10556609 as applied in the double patenting rejection above further in view of WO-00/24527, as literally translated in US 6548121. Though '609 does not claim the substrate of claims 3-5 or the additives of claim 14, as described in the Bauer et al rejections of those claims, it would have been obvious to a person of ordinary skill in the art at the time of invention to perform those claimed limitations since they were known to the art to be suitable and would produce predictable results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**20. Claims 1, 2, 10, 12, 13 and 15-21** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10566741. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '741 claims are sufficient to anticipate species from the markush groups in the claims. Additionally, the photoinitiator compounds are in solutions (claim 7) and the claims require that the coatings are strongly adherent, which means that the layers must interact with each other. Furthermore: MPEP 2144.05 (II) states that "Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such

concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation."

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**21. Claims 3-5, 7-9, 11, 14 and 22** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10566741 as applied in the double patenting rejection above further in view of WO-00/24527. Though '741 does not claim the substrate of claims 3-5, the coatings of claims 7-9 and 22, the deposition methods of claim 11 or the additives of claim 14 as described in the Bauer et al rejections of those claims, it would have been obvious to a person of ordinary skill in the art at the time of invention to perform those claimed limitations since they were known to the art to be suitable and would produce predictable results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**22. Claims 1, 2, 10, 12, 13, 15-21** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10566743. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '743 claims are sufficient to anticipate species from the markush groups in the claims. Additionally, the photoinitiator compounds are in solutions (claim 7) and the claims

require that the coatings are strongly adherent, which means that the layers must interact with each other. Furthermore: MPEP 2144.05 (II) states that "Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. '[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.'"

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**23. Claims 3-5, 7-9, 11, 14 and 22** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10566743 as applied in the double patenting rejection above further in view of WO-00/24527, as literally translated in US 6548121. Though '743 does not claim the substrate of claims 3-5, the coatings of claims 7-9 and 22, the deposition methods of claim 11 or the additives of claim 14, as described in the Bauer et al rejections of those claims, it would have been obvious to a person of ordinary skill in the art at the time of invention to perform those claimed limitations since they were known to the art to be suitable and would produce predictable results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

24. **Claims 1-5, 7-22** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/538893 further in view of WO-00/24527, as literally translated in US 6548121. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '893 claims are sufficient to anticipate species from the markush groups in the claims. Though the '893 claims do not require that the coatings have functional groups that interact to create adhesion, as described in the Bauer et al rejections of those claims, it would have been obvious to a person of ordinary skill in the art at the time of invention to perform those claimed limitations since they were known to the art to be desirable (better adhesion) and would produce predictable results.
25. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.
26. **Claims 1-5, 7-22** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/530614 as applied in the double patenting rejection above further in view of WO-00/24527, as literally translated in US 6548121. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '614 claims are sufficient to anticipate species from the markush groups in the claims. Though the '614 claims do not require that the coatings have functional groups that interact to create adhesion, as described in the Bauer et al rejections of those claims, it would have been obvious to a person of

ordinary skill in the art at the time of invention to perform those claimed limitations since they were known to the art to be desirable (better adhesion) and would produce predictable results.

27. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

28. No current claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOEL G. HORNING whose telephone number is (571) 270-5357. The examiner can normally be reached on M-F 9-5pm with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael B. Cleveland can be reached on (571)272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. G. H./

Examiner, Art Unit 1792

/Michael Cleveland/

Supervisory Patent Examiner, Art Unit 1792